

REMARKS

The Office Action mailed July 23, 2003 has been carefully reviewed and the following remarks are made in response thereto.

Claims 1 and 2 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,890,140 to Clark et al. ("Clark") in view of U.S. Patent No. 5,500,890 to Rogge et al. ("Rogge"), claims 8–50 and 129–148 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Clark, and claims 3–7 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Clark in view of Rogge and in further view of Official Notice. Claims 1–50 and 129–148 are pending in the present application.

In view of the following remarks, the Applicants submit that claims 1–50 and 129–148 are allowable over the cited art, and respectfully request that the Examiner reconsider and withdraw the pending § 103 rejections.

The Applicants Request Complete Examination Under MPEP § 707.07

Claims 8–50 and 129–148 are rejected under § 103(a) as anticipated by Clark. However, in issuing the § 103(a) rejection for these 63 claims, the Examiner cites elements particular to claim 129 only. The Examiner does not cite or address any of the elements recited by claims 8–50 and 130–148, and has, therefore, failed to substantively examine claims 8–50 and 130–148 on the merits of each individual claim. *See*, Office Action at Pages 4–5. Similarly, in the preceding two (2) Office Actions mailed August 21, 2002 and February 13, 2003, respectively, claims 8–50 and 129–148 were not substantively examined on the merits of each individual claim. The Applicants' representative noted this deficiency to the Examiner during the telephone interview conducted on September 3, 2002, in the Response filed on November 21, 2002, and in the Response filed on May 13, 2003. Consequently, the Applicants request that the Examiner withdraw the outstanding Office Action and issue a new Office Action in which each of the elements of claims 8–50 and 130–148 are substantively examined, or, in the alternative, issue a Notice of Allowance. *See*, MPEP § 707.07, "Completeness and Clarity of Examiner's Action;" MPEP § 707.07(g), "Piecemeal Examination."

When the Examiner reviews all of the claims, it will be clear they are allowable over the cited art. While many examples of the differences between the 7 examined claims (i.e., claims

1, 2, 3, 5–7 and 129) and the 62 unexamined claims (i.e., claims 8–50 and 130–148) may be described, two examples are highlighted below.

In the first example, claim 8 recites, in pertinent part, “a translator for reading and writing files in the native language of the NCD software, and read and write files in the native language of the client software.” This feature is not recited in claims 1, 2, 3, 5–7 or 129; consequently, the Examiner has failed to address this element in the pending Office Action. Even if the Examiner had reviewed these claims, it would be clear that both Clark and Rogge can not serve as prior art as both are entirely silent on whether a network communications device may include a translator.

In the second example, claim 130 recites, in pertinent part, “receiving the offer and data file from the data recipient computer,” “processing the data file,” “creating the message,” and “sending the offer and the message to the data repository.” These features are not recited in claims 1, 2, 3, 5–7 or 129; consequently, the Examiner has failed to address these elements in the pending Office Action. Even if the Examiner had reviewed this claim, he would have concluded that both Clark and Rogge are entirely silent on whether an offer and data file may be received at a network communications device, or whether the data file may be processed. Furthermore, both Clark and Rogge fail to disclose that a message may be created, or that the offer and message may be sent from the network communications device to a data repository (*See also*, Remarks directed to claim 129 below).

The Pending Claims Are Allowable Over the Cited Art

Clark is directed to a system for delivering financial services to different geographical locations and time zones, and includes a global interface device (GID) 10, one or more customer facilities (CF) 12, a global telecommunications network (GTN) 13, and a plurality of on-line transaction processors (OLTP) 14. *See*, e.g., Abstract; FIG. 1; Col. 3, lines 5–14; Col. 4, lines 50–60; Col. 29, lines 2–30. Rogge is directed to point-of-sale systems using a dial-up asynchronous communications protocol between single terminal store 36, or multi-terminal store 10, and FEP/Host 29 over virtual network 34. *See*, e.g., Abstract; FIG. 1; Col. 5, line 19 to Col. 6, line 29; Col. 6, lines 30–55. The Applicants respectfully submit that both Clark and Rogge fail to disclose many features of the claimed invention.

Claims 1–50 Are Allowable

Claim 1 is directed to a system for data recipient invoked electronic transactions, and recites, in pertinent part, a "data recipient computer having web server software for hosting a web page." The Examiner cites to Clark's Abstract and FIG. 1 to support the § 103 rejection. *See*, Office Action at Page 3. The Applicants disagree and submit that Clark is entirely silent on whether his system includes a computer having web server software for hosting a web page. Furthermore, because Clark fails to disclose any of the protocols associated with web server software, Clark also fails to suggest the use of web server software. Instead, Clark discloses a "specially developed software package" that includes various software applications, none of which disclose, teach or suggest the use of web page hosting software. *See*, e.g., Col. 18, lines 22–34; FIGS. 15, 17, 20, 23, 24, 28, etc. Similarly, Rogge is entirely silent on whether his system includes a computer having web server software for hosting a web page. Furthermore, because Rogge fails to disclose any of the protocols associated with web server software, Rogge also fails to suggest the use of web server software. Consequently, neither Clark nor Rogge disclose the claimed "data recipient computer having web server software for hosting a web page."

Claim 1 also recites, in pertinent part, at least one data recipient computer having client software that includes "instructions for forwarding a data recipient's offer to the at least one data repository via the gateway computer, the second network, and the NCD software." The Examiner notes that Clark fails to disclose this feature and Applicant, naturally, agrees. However, the Examiner cites Rogge, Col. 6, lines 31–40 and Col. 9, lines 1–11, to support the § 103 rejection. *See*, Office Action at Page 3. The Applicants disagree and submit that Rogge fails to disclose this feature. While Rogge discloses that controller 24 may send credit card authorization messages to FEP/Host 29 over virtual network 34, Rogge is entirely silent on whether a data recipient's offer may be forwarded from the data recipient's computer to a data repository via a gateway computer, a second network and NCD software. Rather, Rogge discloses that the connection between controller 24 and FEP/Host 29 is accomplished via direct access line 30 to carrier point-of-presence 32, and then through virtual network 34 to network interface 33 using an inter-exchange carrier (IXC). *See*, e.g., Col. 6., line 31–55. Accordingly, Rogge discloses only a single, virtual connection between controller 24 and FEP/Host 29, and fails to teach or suggest the claimed "instructions for forwarding a data recipient's offer to the

at least one data repository via the gateway computer, the second network, and the NCD software."

Moreover, both Clark and Rogge fail to disclose a "data recipient's offer." As described within the Specification, "the present invention allows data subject 100 to purchase a product or service (hereinafter an "item") over common network 160 and allows data recipient 104 to receive payment information relating to the transaction" (Page 9, lines 13–15). Accordingly, an "offer" in the context of the present invention is a proposal to purchase the item, as in "something, such as a suggestion, proposal, or bid that is offered" (*The American Heritage Oxford Dictionary, Third Edition*, Houghton Mifflin Company, 1997, Page 947). Clark discloses a securities application that allows the user to "create, verify, authorize, view affirmations and view all securities transactions" (Col. 20, line 66 to Col. 21, line 1). Clark does not include any proposal to purchase an item and therefore fails to disclose the claimed "data recipient's offer." Rogge discloses a dial-up asynchronous communications protocol for multi-threaded credit card authorizations between point of sale terminals and a host processing system, and also fails to disclose the claimed "data recipient's offer." See, e.g., Col. 3, line 51 to Col. 4, line 36.

Consequently, the Applicants respectfully submit that both Clark and Rogge fail to disclose a "data recipient computer having web server software for hosting a web page," a "data recipient's offer," or "instructions for forwarding a data recipient's offer to the at least one data repository via the gateway computer, the second network, and the NCD software," as recited by claim 1. Accordingly, claim 1 is allowable over the cited art. Claims 2–50, depending from claim 1, are also allowable at least for the reasons discussed above.

Claims 129–148 Are Allowable

Claim 129 is directed to a method for purchasing an item over a first network coupled to a second network by a gateway, and recites, in pertinent part, "receiving a request for an offer from a data subject" and "sending the offer and a data file from the data recipient computer to the data subject" at a data recipient. The Examiner cites the Abstract and FIG. 1 to support the § 103 rejection. See, Office Action at Page 4. The Applicants respectfully disagree, and submit that Clark is entirely silent on whether a request for an offer may be received by any element of his system. The Abstract does include the word "requested," but it is used in an entirely different context, i.e., "A system for communicating with a global electronic delivery system that integrates a plurality of financial services provided at different geographical locations and in

different time zones, and delivery [sic] such services directly to a customer facility at any time requested by the customer." Furthermore, Clark also fails to disclose that an offer and a data file may be sent to any element of his system.

Claim 129 also recites, in pertinent part, "receiving the offer and a message from the data subject" and "presenting the offer to the data subject" at a data repository. The Examiner cites FIG. 15, Col. 20, lines 65–67, Col. 21, lines 1–60 and Col. 14, lines 14–21 to support the § 103 rejection. *See*, Office Action at Pages 4–5. The Applicants respectfully disagree, and submit that Clark is entirely silent on whether an offer and a message may be received by any element of his system. Furthermore, Clark also fails to disclose that the offer may be presented to the data subject.

Moreover, while the Examiner did not cite Rogge against claim 129, the Applicants submit that Rogge also fails to teach or suggest many features recited by this claim.

Consequently, claim 129 is allowable over the cited art. Claims 130–139, depending from claim 129, are also allowable, at least for the reasons discussed above. Claim 140 is directed to a system for conducting electronic transactions, and recites elements comparable to claim 129. Consequently, claim 140 is also allowable over the cited art. Claims 141–148, depending from claim 140, are allowable as well, at least for the reasons discussed above.

Accordingly, the Applicants respectfully request that the Examiner reconsider and withdraw the pending § 103 rejections.

CONCLUSION

In view of the remarks submitted above, the Applicants respectfully submit that the present case is in condition for allowance. A notice to that effect would be greatly appreciated.

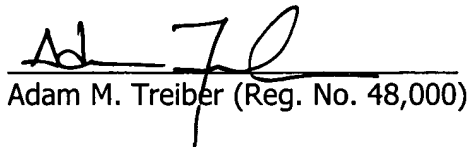
The Examiner is invited to contact the undersigned at (202) 220-4294 to discuss any matter concerning this application.

The Office is authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 11-0600.

Respectfully submitted,

KENYON & KENYON

October 22, 2003


Adam M. Treiber (Reg. No. 48,000)

1500 K Street, N.W.
Washington, D.C. 20005
(202) 220-4200 (phone)
(202) 220-4201 (fax)

DC:472935_2.DOC